

REMARKS

Claims 1-3, 5, 8, 9, 11-19 and 21 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of Brugger et al. (6,156,419) in view of Malhotra (5,589,277). Claim 20 stands rejected under the same basis further in view of Floegel et al. (6,284,339), Uemura et al. (6,153,305) and Kasahara et al. (6,165,606).

Claims 1, 5, 8, 9 and 11-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP 614,771 to Harasawa et al. in view of U.S. Patent No. 5,573,582 to Inui et al. and WO 95/28285 to Fryberg et al.

Claims 1-3, 8, 9 and 11-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10217603 to Tomioka et al. in view of Inui et al. and Fryberg.

The Examiner has objected to Claim 1 as confusing and has objected to Claims 8 and 11 as depending from a canceled claim. Claim 1 has been amended herein to clarify that "said porous inorganic oxide" further includes at least one element of the rare earth metal series of the periodic system of elements with atomic numbers 57 to 71. Claims 3, 8 and 11 have been amended to provide proper dependency.

Claim 1 has also been amended to include the limitation of Claim 2, which has now been canceled. Claim 17 has been amended to be consistent with the amendments made to Claim 1.

NONSTATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS

The Examiner has rejected claims 1-3, 5, 8, 9, 11-19 and 21 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of Brugger et al. (6,156,419) in view of Malhotra (5,589,277).

The Examiner states that Brugger claims ink jet recording sheets including aluminum oxide modified with rare earth metals and Malhotra teaches a recording sheet containing lactic acid, binders and inorganic oxides as well as the inclusion of an additive hydroxyl acid including aliphatic hydroxycarboxylic acids. Accordingly, she states it would have been obvious to one of ordinary skill in the art to utilize Malhotra's additive in Brugger's recording layer to obtain the advantages of the present invention. Applicants respectfully disagree.

Applicants acknowledge that Brugger discloses aluminum oxide modified with rare earth metals, but in contrast to the present invention claims Brugger does not disclose the use of an aliphatic hydroxycarboxylic acid with more than 2 carbon atoms such as a water soluble monohydroxymonocarboxylic acid.

Malhotra discloses a recording sheet made of a substrate of either paper or transparent film coating of at least one surface with a quaternary acrylic copolymer latex binder and an additive material selected from the group consisting of monomeric amino acids, monomeric hydroxy acids and mixtures thereof. The particular coating composition in Malhotra that includes hydroxycarboxylic acids is intended to promote rapid drying times and reduced curl subsequent to being imaged. See Malhotra Col. 10 lines 26 to 42. In contrast, the specific coating solutions of

the present invention are comprised of a combination of a water soluble monohydroxymonocarboxylic acid, binders and colloidal aluminum oxide, colloidal aluminum oxide/hydroxide or pseudo-bohemite modified with rare earth metals which provide the resulting recording sheet with improved light fastness. See Applicant's specification page 3 lines 14-17 for support.

It is well settled that the mere fact that the prior art could be modified to form the invention would not make the modification obvious *unless the prior art suggested the desirability of the modification*. *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The Examiner has not set forth any motivation or suggestion in the cited art which would motivate or suggest to one skilled in the art to make the claimed invention. Applicants believe there is no motivation to combine the Brugger teaching of coating solutions which include aluminium oxide modified with rare earth metals with the hydroxy acids disclosed in Malhotra. Further, there is no motivation to take out only one element of the Malhotra coating composition - the hydroxy acids - and combine this element with Brugger to obtain the invention as claimed which has improved light fastness properties.

Accordingly, Applicants believe the ground of nonstatutory obvious-type double patenting over Brugger in view of Malhotra has been overcome and should be withdrawn.

Applicant asserts the rejection of Claim 20 is now moot since the grounds for rejection are based on Brugger in view of Malhotra in further view of Floegel, Uemura and Kasahara.

OBVIOUSNESS REJECTIONS

Claims 1, 5, 8, 9 and 11-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP 614,771 to Harasawa et al. in view of U.S. Patent No. 5,573,582 to Inui et al. and WO 95/28285 to Fryberg et al.

The hydroxycarboxylic acids disclosed in Harasawa are described to include an aromatic nucleus or at least two carboxyl groups (see page 2 lines 14-15, lines 38-48). As now amended, Claim 1 now contains the limitation from dependent Claim 2 and defines the aliphatic hydroxycarboxylic acid with more than 2 carbon atoms as a water soluble monohydroxymonocarboxylic acid.

Accordingly, in view of the amendments to Claim 1, the combination of Harasawa, Inui and Fryberg do not make the invention as now claimed obvious.

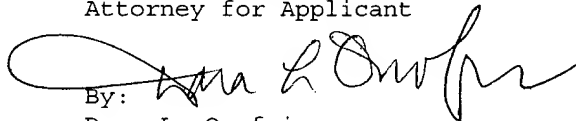
Claims 1-3, 8, 9 and 11-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10217603 to Tomioka et al. in view of Inui et al. and Fryberg.

JP 10217603 to Tomioka was published on August 18, 1998, which is after the priority date of the present application which is June 18, 1998 (European Patent Application No. 98810556.5). Included with this response Applicant submits an exact translation of the priority application along with a Statement by Dr. Jakob Kuhn as to the accuracy of this translation.

Accordingly, the Tomioka reference should be removed as prior art thus making the rejection in combination with Inui and Fryberg moot.

In view of the foregoing arguments, Applicant submits that this application is now in condition for allowance. No new matter has been introduced by this Amendment. Reconsideration of this application and allowance of Claims 1, 3, 5, 8, 9 and 11-21 are hereby requested. If a telephone interview would be useful to advance this case, then the Examiner is invited to telephone the undersigned.

Respectfully submitted,
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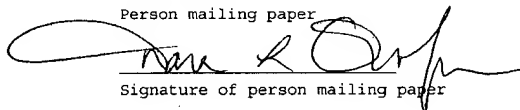
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